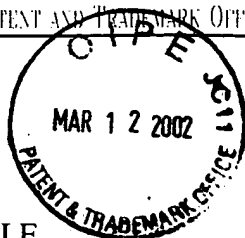




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OFFICE OF PETITIONS

JORDAN A. SIGALE
SONNENSCHN NATH & ROSENTHAL
P.O. BOX 061080
WACKER DRIVE STATION SEARS TOWER
CHICAGO, IL 60606-1080

OFFICE OF PETITIONS

In re Application of
Budniak, Coia & Wottrich
Application No.: 09/748,068
Filed: December 22, 2000
Attorney Docket No.: 9771110-0007
For: MULTI-TEST CIRCUIT BREAKER
LOCATOR

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed August 9, 2001 (certificate of mailing August 7, 2001).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on December 22, 2000 without an executed oath or declaration and filing fees. Accordingly, on February 7, 2001, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring substitute drawings, an executed oath or declaration, filing fees, and a surcharge for their late filing.

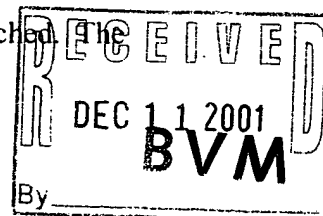
In response, on August 9, 2001 (certificate of mailing date August 7, 2001), a declaration executed by joint inventor Coia and an addendum signed by joint inventor Coia on behalf of Unique Technologies, LLC, a company with proprietary interest in the invention, documents establishing LLC's proprietary interest, the surcharge, a six month extension of time with required fee, substitute drawings, and the instant petition and required fee were filed. A declaration of facts of Attorney Jordan A. Sigale, the attorney of record, accompanied the petition. Attorney Sigale states that Ms. Paula M. Theismann, a patent paralegal in the attorney's firm, sent a copy of the application, declaration and assignments to Inventor Wottrich's last known address, but it was returned as undeliverable.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (1) and (2) above.

As to item (1), Applicants have failed to establish that the inventor cannot be reached. The



statement of facts of Attorney Sigale states that Ms. Theismann mailed a copy of the application papers to the last known address of Inventor Wottrich and that it was returned as undeliverable. Attorney Sigale states other efforts to reach the inventor occurred, but does not provide details/documentation concerning those efforts. The showing of record is not sufficient to show diligence on the part of applicants in finding the missing inventor.

Another copy of the application papers should be sent to the last known address of the non-signing inventor with a request that he sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail, computer based searches - LEXIS- or the telephone continue to fail, then applicants will have established that the inventor cannot be reached.. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration submitted with the instant petition was signed by two of the named inventors. Only one of the inventors signed an addendum to the declaration on behalf of Unique Technologies, LLC, a company with proprietary interest.

An empowered representative of an entity with proprietary interest may sign the declaration only when no inventor is available. In this instance, two inventors have signed the declaration. Therefore, the addendum signed by one inventor/ empowered representative of the company in interest renders the declaration unacceptable.

The signing inventors must sign the declaration for the application of behalf of themselves and on behalf on the non-signing inventor. The declaration will be acceptable if the signing inventors sign in their respective signature blocks and the signature block of the non-signing inventor is left blank **OR** if both of the signing inventors sign a document that states he is signing on behalf of the non-signing inventor. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47(a) applicant on behalf of Mr. Wottrich is **REQUIRED**. See MPEP 409.03(a).

It appears that petitioners have submitted documents with the intention of having an entity with a proprietary interest intervene and make the application on behalf of the non-signing inventor. Petitioners are reminded that when one joint inventor signs, the provisions of 37 CFR 1.147(a) apply. Where 37 CFR 1.147(a) is available, application cannot be made under 37 CFR 1.147(b). MPEP 409.03(b).

Regarding finances, petitioners submitted a check for \$595.00, rather than \$695.00, which was the amount stated in the Request for Extension of Time, filed August 9, 2001 (certificate of mailing August 7, 2001). Pursuant to petitioners' authorization, deposit account No. 19-3140 was charged the \$100.00 difference.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries should be directed to the undersigned at (703) 308-6712.

A handwritten signature in cursive script, reading "E. Shirene Willis".

E. Shirene Willis
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy